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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/955,804 | 09/19/2001 | Thomas J. Pavela | ST9-98-107US2 | 1404 |
| 7590 | 06/01/2004 | | EXAMINER | |
| Attention of Victor G. Cooper Gates & Cooper LLP Howard Hughes Center 6701 Center Drive West, Suite 1050 Los Angeles, CA 90045 | | | VO, TED T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2122 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------------|--|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/955,804 | PAVELA, THOMAS J.  |
| | Examiner Ted T. Vo | Art Unit 2122 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 March 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 22-36 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 22-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. Applicants' arguments filed on March 3, 2004, responding to the Office action (Dec 24 2003) provided in the rejections of Claims 22-36, have been fully considered. The filing terminal disclaimer, filed with the same date, overcomes the rejection of Claims 22-36 under the judicially created doctrine of obviousness-type double patenting. As a result, the rejection of double patenting to Claims 22-36 is withdrawn. Claims 22-24, 26-29, 31-34, 36 are rejected under 35 U.S.C. 102(a) as being anticipated by Smith Jr. (US No. 5,754,755). Claims 25, 30, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith.

Claims 22-36 are pending in the application.

Response to Arguments

2. Applicant's arguments in section Remarks (pages 6-13) with respect to claims 22-36 have been fully considered. However, the arguments are not persuasive.

For example:

a. With regard to Claims 22, 27, 32, Applicants points out test template file 112 and Customize file 114 and argue that "placeholders" are not analogous to tags. Applicants reason that placeholders are not associated with executable code object 314 defining a set of instruction for performing a portion of automatic test procedures (Re: Remarks: Page 8, third paragraph).

Examiner respectfully disagrees:

In the first action, Examiner's citations include *HTML template file* disclosed by Smith at column 7, lines 25-30 (See Prior action page 4). In this column, Smith states, "*The output file generator of the present invention generates a Web page using user independent WEB page template file and the customizing data files. For example, the HTML template file might contain placeholder for stock price and volume data*" (Emphasis added). Fig. 1 shows such output file generator 110 that generates Test Template File 112 and Customizing Files 114 that are corresponding to WEB page template file and

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customizing data files. Smith discusses the placeholder not in a separated manner, but it is associated with the HTML template file (*source file*). In the arguments of Claims 22, 27, 32, Applicants are silent on "HTML template files" that associated with *placeholders* as cited in the previous action for covering limitation "*defining a source file having a plurality of tags*".

With regards to Applicants reasoning that *placeholders* are not associated with executable code object 314 defining a set of instruction for performing a portion of automatic test procedures (re: Remarks: page 8), Examiner disagrees. As noted above *placeholders* are associated with HTML tags that cover the limitation: *each tag associated with a member of a library of executable code objects defining a set of instructions for performing a portion of automatic test procedure*. It is noted that placeholder is used with HTML tags as addressed by Smith (Column 7, lines 26-30). To interact with library functions, it requires a value being placed in the placeholder. For example, at column 4, lines 15-20, a name of a function such as *function2* (claimed limitation: *a member of a library of executable code objects*) is placed in the placeholder; a command "*execute function2*" invokes this function for execution. The reference of Smith associates with HTML tags. Furthermore, right in the column 2, lines 45-58, Smith states "*the output generator receives a test template file that has statements that are test instructions or iterative commands, and that has place holders*". Thus, *test instructions*, or *iterative commands* generated by Output File Generator 110, not by a user; therefore, *test instructions* and *iterative commands* also have means of "*a member of a library of executable code objects defining a set of instructions for performing a portion of automatic test procedure*".

In the Remarks, at page 11, second paragraph, Applicants asserted that the claim is not directed to creating a test program that is applicable to different applications, but rather, a system that guides generation of test cases.

Examiner respectfully responds: Smith teaching is a method for generating a test script (See column 2, lines 25-28), not a test program. The test script contains test instructions for testing an application program. Furthermore, with the plain languages of Claim 22, Smith discloses in the same manner. As discussed above, Smiths discloses defining a templates including HTML template, generating test plans and document for guiding tests, and generating a test code for test script as

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discussed (Column 2, lines 45-58, column 7, lines 10-53) which correspond to limitation recited in Claim 22.

b. With regard to Claims 24, 29, and 34 (re: Remarks: page 11), Applicants merely argue Smith's scanning (Column 3, lines 45-48) does not disclose "test index identifying system elements tested by the test code" nor scanning the interpretable tags to identify the system elements tested by the test code" (re: Remarks: page 22, last paragraph).

Examiner respectfully disagrees:

"Scanning" has means for identifying. Particularly, Smith shows scanning means (Column 3, lines 45-48). Although the scanning is for a customizing file for searching values of place holder, this teaching includes scanning test instructions or iterative commands (See column 2, lines 45-58), HTML templates (Column 7, lines 10-53) that contain tags and place holders.

Smith teaching includes HTML template with placeholders, and HTML tags for generating documents and test plans. HTML tags provide identifying elements associated with it. As discussed above for "Function*", Smith refers the symbol "*" as indexing that causes a function with a particular index would be executed. For example, "execute function2" (*test index identifying system elements tested by the test code*) (See Column 4, lines 22-28). And with the scanning means is used by Smith, it is obvious that scanning would interpret tags in the HTML template filed that associated with "function2".

c. With regard to Claims 26, 31, and 36 (re: Remarks: page 12), Applicants argue Smith does not disclose *generating test code for automated test procedure comprises the step translating the executable code object associated with the tag the source file*.

Examiner respectfully disagrees: As discussed above, Smith discloses generating test script and test plan using Test template file (HTML template included). The step of generating provides the test template with test instructions and iterating commands (*executable code object*), and placeholders (See column 2, lines 45-58) including HTML tags as discussed above. These teachings cover the claimed limitation.

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d. With regard to Claims 25 (and 30, 35) (re: Remarks: page 12), Applicants assert "the Office Action analogized "tags" to "placeholders" (Re: Remarks: Page 12) then addressed that Ordinary skill in the art would not perform a syntax error check on a placeholder for data.

Examiner respectfully responds:

As noted above, while the prior action citation includes HTML tags, Applicants are silent on HTML tags as cited in the previous Office action in regard to Claim 22. In the previous Office action, it was not associated syntax error check to a *placeholder*, but addressed of syntax error and issuing the error as the well known features that are associated in all type of programming in dealing with syntax and semantic checking. The ordinarily skilled in the arts would know that the syntax check is performed in test instructions, iterative commands, and tags of the HTML script.

Since Applicants arguments are not persuasive, particularly, Applicants silent on part of Examiner's citations: HTML tags included with "placeholders", the rejection remains as given below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 22-24, 26-29, 31-34, 36 are rejected under 35 U.S.C. 102(a) as being anticipated by Smith Jr. (US No. 5,754,755) (hereafter: Smith).

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per claim 22: Smith discloses,

*"defining a source file having a plurality of tags (see figure 1, reference numbers 112 and 114, and see column 7, lines 25-30, 'HTML template file'), each tag ('placeholder' or tags in HTML template file) associated with a member of a library of executable code objects defining a set of instructions for performing a portion of automatic test procedure" (See column 2, lines 45-58, *test instructions, iterative commands*, column 4, lines 15-29, *function*, function2*, column 5, lines 49-65, OBJECT1, OBJECT2, OBJECT3);*

generating a test plan in a conversational language from the source file (see column 7, lines 42-47, 'the generator is particularly useful in generating documents that describes a test plan');

generating the test code ('test instructions') for the automated test procedure ('application-specific test script') from the source file ('test template file')" (See column 2, lines 45-58, referring to 'test instructions' line 47, 'application-specific test script' line 58, 'test template file' line 46).

As per claim 23:

Smith discloses, *"The method of claim 22, wherein the step of generating a test plan comprises the steps of: translating the tags; and generating a conversational language phrase for each translated tag"*, by using a generator to convert the template included with test plan documentation into a test plan document (see Smith: column 7, lines 40-47, 'the generator is particularly useful in generating documents')(Examiner note: HTML script is translated by a Web browser into readable text).

As per claim 24:

Smith discloses, *"the method of claim 23 wherein the test plan comprises a test index identifying the system elements tested by the test code"* (As mentioned, Smith discloses test script generator that can generate a customizing file [see Smith column 3, lines 29-59]. Test plan is included in this customizing file [see Smith: column 7, lines 40-47, 'the generator is particularly useful in generating documents']. Smith provides that each indexing object, OBJECT1, OBJECT2, OBJECT3 [column 5, lines 55-65; and referring

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column 4, lines 7-15, 'indexed placeholder'] is identified by the generator in a script generation, then the generator searches for its value and replaces the value with instructions).

Smith discloses, "*the test index generated by performing the step of scanning the interpreted tags to identify the system elements tested by the test code*" (see Smith, column 3, lines 45-48).

As per claim 26:

Smith teaches translating Test template file and Customizing file (Fig. 1, reference no. 112, and reference no. 114) into the application-specific test script by storing the values of placeholders in the Test template file and Customizing file (See column 2, lines 45-58). These Test template file and Customizing file could be HTML template files (column 7, lines 25-30). The translation includes generating test instructions, iterative commands or restoring a value of an object/function (See column 2, lines 45-58, *test instructions, iterative commands*, column 4, lines 15-29, *function**, *function2*, column 5, lines 49-65, OBJECT1, OBJECT2, OBJECT3)". This covers the limitation: "*where the step generating test code for automated test procedure comprises the step translating the executable code object associated with the tag the source file*" (Column 2, lines 45-58; and see column 5, lines 49-65).

As per claim 27:

Claim 27 is an apparatus claim that has the functionality corresponding to the method claim 22.

Therefore, claim 27 is rejected in the same reason set forth in connecting to the rejection of claims 22.

As per claim 28:

Claim 28 is an apparatus claim that has the functionality corresponding to the method claim 23.

Therefore, claim 28 is rejected in the same reason set forth in connecting to the rejection of claims 23.

As per claim 29:

Claim 29 is an apparatus claim that has the functionality corresponding to the method claim 24.

Therefore, claim 29 is rejected in the same reason set forth in connecting to the rejection of claims 24.

As per claim 31

Claim 31 is an apparatus claim that has the functionality corresponding to the method claim 26.

Therefore, claim 31 is rejected in the same reason set forth in connecting to the rejection of claims 26.

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As per claim 32:

Claim 32 is program storage device in which its claimed steps correspond to the steps recited in the method claim 22. Therefore, claim 32 is rejected in the same reason set forth in connecting to the rejection of claims 22.

As per claim 33:

Claim 33 is program storage device in which its claimed steps correspond to the steps recited in the method claim 23. Therefore, claim 33 is rejected in the same reason set forth in connecting to the rejection of claims 23.

As per claim 34:

Claim 34 is program storage device in which its claimed steps correspond to the steps recited in the method claim 24. Therefore, claim 34 is rejected in the same reason set forth in connecting to the rejection of claims 24.

As per claim 36

Claim 36 is program storage device in which its claimed steps correspond to the steps recited in the method claim 26. Therefore, claim 36 is rejected in the same reason set forth in connecting to the rejection of claims 26.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 25, 30, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (Smith, Jr.) (US No. 5,754,755).

As per claim 25:

Smith discloses a generator that generates a test plan in form of an HTML output file. The file comprises placeholders and HTML tags.

With regards to claim limitation of claim 25: "*The method of claim 23, wherein the step of generating a test plan further comprises the steps of: identifying an un interpretable tag in the test plan; and appending the test plan with an error message identifying the un interpretable tag*",

The claim limitation has means of syntax error checking.

Smith does not address syntax error (*identifying an un interpretable tag*) that causes a returned message (*appending the test plan with an error message*) in generating a test plan using tags and placeholders.

However, syntax checking is well known in the art. Syntax is usually identified by a computer system or syntax check support of a given computer programming language. The response of a syntax error is usually returned with an error or a warning message. This is very well known in the art. For example, a prior art of record, IBM Technical Disclosure Bulletin, "FACTOR (Fairchild Sentry VIII Tester Language) SYNTAX Checker/Analyzer", discloses displaying an error message when a syntax error is occurred.

Official notice is taken that syntax check is well known in the art for providing an identification of an error.

It is used commonly for providing error identification of any computer execution.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include for taking advantage of the well-known feature. The motivation is provided for conforming to an execution requirement for ensuing error free.

As per claim 30:

Claim 30 is an apparatus claim that has the functionality corresponding to the method claim 25.

Therefore, claim 30 is rejected in the same reason set forth in connecting to the rejection of claims 25.

As per claim 35:

Claim 35 is program storage device in which its claimed steps correspond to the steps recited in the method claim 25. Therefore, claim 35 is rejected in the same reason set forth in connecting to the rejection of claims 25.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (703) 308-9049. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM ET. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552.

The fax phone numbers:

(703) 872-9306 (for formal communication intended for entry);

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(703) 746-5429 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

TTV
Patent Examiner
Art Unit: 2122
May 25, 2004



TUAN DAM
SUPERVISORY PATENT EXAMINER